REMARKS

Claims 1-7 (of which claims 1, 3, 5, 6 are independent) are currently pending. In the Office Action mailed June 27, 2003, all pending claims (e.g., claims 1-7) were rejected under 35 U.S.C. § 103(a). Applicants respectfully traverse. To establish a *prima facie* case of obviousness under § 103, there must be some suggestion or motivation to modify the cited references, and the cited references must teach or suggest all the claim limitations. (MPEP §2142).

I. Claims 1 and 3

Claims 1 and 3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jordan et al., U.S. Patent Number 4,313,035 (Jordan '035) in view of Pepper et al., U.S. Patent Number 5,930,700 (Pepper '700). Applicants submit that neither Jordan '035 nor Pepper '700, separately or in combination, teach or suggest a PID comprising "an account update function to send a message ... containing the user profile telephone number and a request to set the user's telephony account telephone number to the user profile telephone number." (Claim 1). Claim 3 contains similar language ("an accounts program ... operable to receive a message to set a user telephone number, each user account containing a telephone number entry, the accounts program being operable to set the telephone number entry in response to the message").

Jordan '035 teaches that a user may set a person locator number (PLN) within a subscribed service if the subscriber wishes to provide a number where the subscriber can be reached while he is traveling. (Jordan '035, Col. 4, lines 30-35). To do so, the subscriber initiates an update call to a local office, and then keys in a "0" followed by the digits "700," a PIN, and his PLN. The "0" informs the system that the subscriber wishes to key-in other digits in addition to those already received. Thus, the system prompts the subscriber for the additional

digits. (Jordan '035, Col. 4, lines 35-65). It is assumed that in response to the prompt for additional digits, the subscriber keys in a three digit access code (e.g., 700) and a four-digit number referred to as the PIN. The access code identifies the call as a certain type of PL update and the PIN is a security number assigned to the subscriber. (Jordan '035, Col. 4 line 65 – Col. 5 line 5). If no PIN is entered, then the attempt to update a telephone number is considered invalid. (Jordan '035, Col. 6 lines 63-67). Thus, to complete the telephone number update, the subscriber must send multiple messages that include a request to change the number, the PLN itself, an instruction to trigger a prompt for additional digits, and the subscriber's PIN number.

In contrast, claim 1 recites that to update a number, one message is sent "containing the user profile telephone number and a request to set the user's telephony account telephone number to the user profile telephone number." Here, the message contains both the request and the telephone number, whereas in Jordan '035, the subscriber must send multiple messages to request a change, and then another message to set a telephone number. Consequently, Jordan '035 teaches away from the present invention since Jordan '035 requires multiple interactions between the subscriber and the system to update a call forwarding number. Thus, a reference such as Jordan '035 that teaches sending multiple messages (e.g., a message with the PIN, a message with the PLN, etc.) to change a number would not suggest "an account update function to send a message … containing the user profile telephone number and a request to set the user's telephony account telephone number to the user profile telephone number," as in the present invention.

The Examiner states that "Jordan fails to explicitly recite a user interface comprising a display and that the communications network is wireless." The Examiner further states that "Jordan does disclose an embodiment in which the personal information device is a wireless

pager." (Office Action, 6.27.03, p. 3). Applicants disagree. Jordan '035 simply teaches that the subscriber may set a forwarding number to be that of a pager, not that the device (e.g., the PID in the present invention) which sets the forwarding number is a wireless pager.

In any event, the Examiner states that Pepper '700 discloses a PID with a display that may establish a data channel over a wireless network, and that it would have been obvious to one of ordinary skill in the art to modify Jordan '035 in this manner. (Office Action, 6.27.03, p. 3). Applicants contend that Pepper '700 does not make up for the shortcomings of Jordan '035. Pepper '700 teaches an invention that "receives a call, attempts to determine the origin of the call, compares the identified call origin to the subscriber's priority for that origin, determines the subscriber's call delivery preferences for calls of that priority and routes the call accordingly." (Pepper '700, Col. 3, lines 18-24). Pepper '700 further describes that the delivery preferences are stored in a database (e.g., database 308) that automatically synchronizes with information stored in the subscriber's PDA. (Pepper '700, Col. 5, lines 32-38). However, Pepper '700 does not explain how the synchronization occurs. Pepper '700 does not teach or suggest that to update a telephone number, one message is sent "containing the user profile telephone number and a request to set the user's telephony account telephone number to the user profile telephone number," as in claim 1 and similarly in claim 3. Pepper '700 simply does not address this issue.

Thus, since neither Jordan '035 nor Pepper '700 alone or in combination, teach or suggest all the claim limitations of claims 1 and 3, the combination of Jordan '035 and Pepper '700 fails to render claims 1 and 3 obvious. Further, a cited reference (e.g., Jordan '035) that teaches sending multiple messages to change a call number combined with a cited reference (e.g., Pepper '700) that teaches call screening would not suggest "an account update function to send a message ... containing the user profile telephone number and a request to set the user's telephony

account telephone number," in light of the disclosures in the cited references that teach away from the invention.

II. Claims 2 and 5-6

Claim 2 and 5-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jordan '035 and Pepper '700, and further in view of Moon et al., U.S. Patent Number 6,075,992 (Moon '992).

With regard to claim 2, Applicants submit that the combination of the cited references does not teach all of the claim limitations for at least the reasons mentioned above with respect to claim 1.

With regard to claim 5, Applicants submit that the Examiner does not cite any disclosure from Moon '992, thus the rejection will be considered as only being held under Jordan '035 and Pepper '700. As explained with claim 1 above, Jordan '035 and Pepper '700 both fail to teach "sending a request to set the user telephone account to the user telephone number over a data communications channel to a telephony control server wherein the telephony control server updates the user telephone number entry to the user telephone number." (Claim 5). The functions described in Jordan '035 require multiple messages to be sent, and Pepper '700 simply does not address this issue.

With regard to claim 6, none of Jordan '035, Pepper '700, or Moon '992, separately or in combination, teach or suggest all of the claim limitations. For example, the combination of the cited references does not teach "starting a contacts application to display a plurality of contact entries," "selecting one of the contact entries identifying a callee," "initiating a data communications channel to a telephony control server having a user telephone number," and "sending a message to call the callee," as in the present invention. Applicants describe one

example of a method for initiating a telephone call between two PSTN telephones from a wireless PID (as in claim 6) in Figure 9. As described in the patent application, a user invokes a contacts application in the wireless PID to select an entry for a person that the user wishes to call. The user then selects an entry and commands the wireless PID to initiate a telephone call. The wireless PID initiates a wireless data connection to the telephony control server and sends a message to call the person whose telephone number is included in the message. The telephony control server signals gateways to make PSTN telephone calls to the telephones identified by the telephone numbers of the user and the person to which the user desires to call. The gateways establish a voice over data channel over the data network. When the users pick up their telephones, the gateways connect their telephones to the voice over data channel so that they may begin conversing as in a normal telephone call. (Specification, p. 23 line 22 to p. 24 line 4).

As explained above, Jordan '035 teaches that a user may set a PLN within a subscribed service if the subscriber wishes to provide to parties trying to call him while he is traveling of a number where the subscriber can be reached. Jordan '035 does not teach or suggest "initiating a data communications channel to a telephony control server having a user telephone number" and "sending a message to call the callee," such as having a telephony control server signal gateways to make PSTN telephone calls to the telephones identified by the telephone numbers of the user and the person to which the user desires to call in order to connect the telephone call. In contrast, Jordan '035 describes that a call is connected in a conventional manner to its destination once requested by a user. (Jordan '035, Col. 10, lines 50-51).

The Examiner contends that Jordan '035 teaches the above limitations, and states that Jordan '035 discloses "initiating a data communications channel to a telephony control server having a user telephone number (see col. 10 lines 23-30, wherein the user telephone number is

subscriber A's); sending a message to call the callee (see col. 10 lines 28-30)." (Office Action, 6.27.03, p. 8). However, the callee in Jordan '035, i.e., the person to be called, is subscriber A. Thus, subscriber A cannot be both the server and the callee as contemplated by the Examiner. Rather, Jordan '035 teaches that to call subscriber A, caller C simply dials into a local office, which forwards the request on to a database that retrieves a call completion number from memory, and then completes the call in a conventional manner. (Jordan '035, Col. 10, lines 35-50). Thus, Jordan '035 does not teach initiating a data communications channel to a *telephony control server*, and sending a message to call the *callee*, as in claim 6. For example, in Jordan '035, the call completion number is retrieved from memory. Therefore, no message to call the callee is sent.

In addition, Pepper '700 does not address the subject matter of the claim limitations as recited in claim 6 because Pepper '700 merely teaches routing calls based on priority settings. Similarly, Moon '992 only discloses a method of initiating a call that involves determining a local time for a recipient and whether to permit the call based on the time. Moon '992 does not make up for the shortcomings of both Jordan '035 and Pepper '700. Thus, since none of Jordan '035, Pepper '700, or Moon '992, separately or in combination, teach or suggest all of the claim limitations in claim 6, then this combination of references fails to render claim 6 obvious.

Furthermore, there is no suggestion or motivation to modify or combine the cited references. For example, Jordan '035 teaches that a user may set a call forwarding number, and Pepper '700 teaches an invention that involves screening and routing calls accordingly. Thus, both Jordan '035 and Pepper '700 teach methods for routing telephone calls based on different criteria. In contrast, Moon '992 teaches a method of initiating a call based on a local time for the designated recipient. Moon '992 is not concerned at all with routing telephone calls. In contrast,

Moon '992 is directed to an invention dealing with how the calls are initiated. The fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, and thus does not establish any motivation to combine the references. (MPEP § 2143.01). Since there is no teaching or suggestion within either Jordan '035 or Pepper '700 of any desire for including a contacts application, and because Jordan '035 and Pepper '700 are concerned with different problems, then their combination with Moon '992 to render claims 2 and 6 obvious is invalid.

III. Claim 4

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Jordan '035 and Pepper '700, and further in view of Wiedeman et al., U.S. Patent Number 5,448,623 (Wiedeman '623). Applicants submit that the cited combination does not teach all of the claim limitations of claim 4 for at least the reasons discussed above with respect to claim 3. For example, Wiedeman '623 does not make up for the shortcomings of the combination of Jordan '035 and Pepper '700.

IV. Claim 7

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Jordan '035, Pepper '700, and Moon '992, and further in view of Wiedeman '623. Applicants submit that the cited combination does not teach all of the claim limitations of claim 7 for at least the reasons discussed above with respect to claim 6. For example, Wiedeman '623 does not make up for the shortcomings of the combination of Jordan '035, Pepper '700, and Moon '992.
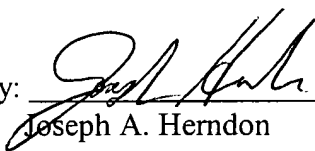
V.   Summary

Applicants respectively submit that in view of the remarks above, all of the pending claims 1-7 are in condition for allowance and such action is respectively requested. The

Examiner is invited to call the undersigned at (312) 913-0001 with any questions or comments.

Respectfully submitted,

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